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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,352	06/15/2000	Leo A. Whiteside	WBC 7403US	8952

1688 7590 05/21/2002

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EXAMINER

SNOW, BRUCE EDWARD

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/595,352

Applicant(s)

WHITESIDE, LEO A.

Examiner

Bruce E Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. 6) ☐ Other: \_\_\_\_\_

***RCE***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/1/02 has been entered.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

I. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12, lines 12-13, "the upper peripheral edge" lacks antecedent basis and is ambiguous. Also note that claim 13 use the language "top" to described the opposite direction as to "upper"? Also line 7, "from liner" is awkward.

Regarding claim 12, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 13, "top" describes the opposite direction as "upper" in claim 12.

***Claim Rejections - 35 USC § 112***

- II. The following is a quotation of the first paragraph of 35 U.S.C. 112:
- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- III. Claims 12-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 12, the specification fails to provide support for "a plurality of tabs, one for each notch". See the specification, page 10, lines 29 et seq. teaching, *"in the preferred embodiment six tabs 60 surround the circumference of liner 42 while twelve notches 36 surround the circumference of liner 42"*.

Regarding claim 12, line 14, the specification fails to teach or support, "snap-fit" describing the fit of tabs and notches.

***Claim Rejections - 35 USC § 103***

- IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parchinski (4,650,491) in view of Schryver et al (5,314,487).

Parchinski teaches a prosthesis comprising a shell 12 having a smooth inner sealing surface 22 (see figure 5); and a liner 14 including at least one circumferential peripheral annular seal 40, said seal engaging and said smooth sealing surface to restrict migration of debris between the interface of the shell and liner. Said shell further comprising a plurality of upper peripheral notches 30; and said liner including a tab 48 which corresponds with a notch to prevent relative rotational movement.

However, Parchinski fails to utilize at least one screw hole. Schryver et al teaches it is well known to utilize at least one screw hole 18 in a shell prosthesis. It would have been obvious to one having ordinary skill in the art to have utilized at least one screw hole as taught by Schryver et al with the prosthesis of Parchinski to more securely affix the prosthesis to an acetabulum.

Regarding using a plurality of tabs, see element 108 of Schryver et al. Also, see column 8, lines 49-53, teaching tabs 108 provide a snap or interference fit with notches 116.

Claims 10-11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parchinski (4,650,491) and Schryver et al (5,314,487) and further in view of Weill (4,596,580).

Parchinski and Schryver et al teach the prosthesis as described above. However, they are silent regarding each notch having a pair of inwardly projecting lips to grasp a respective tab. Referring to 3, Weill teaches a prosthesis having a shell including notches 11 with diverging sides 14, interpreted as "projecting lips" which grasp tab 10 in

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a "snap" relationship. It would have been obvious to one having ordinary skill in the art to have utilized or substituted the notch/tab configuration with the prosthesis of Parchinski and Schryver et al to provide additional securement and/or a configuration which better resists axial separation between the shell and liner and/or is easier to manufacture.

Regarding claim 13, referring to figure 3 of Weill, note that the top of the tab has tapered edges interpreted as being "rounded". In the alternative, the use of a rounded top of said tab is an obvious mechanical substitution to the shape taught by Weill serving the same purpose and would have been an obvious mechanical substitution to one having ordinary skill in the art and/or lacking any criticality in the specification, the use of the rounded top in lieu of the configuration taught by Weill is considered an obvious matter of design choice.

### ***Response to Applicant's Arguments***

Applicant's arguments filed 3/5/02 have been fully considered but are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

bes  
May 16, 2002

A handwritten signature in black ink, appearing to read 'BSN', with a long horizontal line extending to the right.

**BRUCE SNOW**  
**PRIMARY EXAMINER**